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Intellectual Property Section
Law Department
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19

Number of Pages (including this page)

Date: 07/25/2006
To: Commissioner for Patents
Location: United States Patent and Trademark Office
Fax No.: (571) 273-8300
From: Matthew C. Loppnow Registration No. 45,314
Subject: Serial No. 10/693,248 Docket No. CS22815RL

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- Appeal Brief (15 pages)
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- Fee Transmittal Form
- Petition for Extension of Time

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EXAMINER:	Gellin, J.
GROUP ART UNIT:	2617
SERIAL NO.:	10/693,248
FILED:	10/24/2003
INVENTOR:	Gordecki et al.

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TRANSMITTAL FORM <small>(to be used for all correspondence after initial filing)</small>		Application Number	10/693,248
		Filing Date	10/24/2003
		First Named Inventor	Gordecki, Ryszard J.
		Art Unit	2617
		Examiner Name	GELIN, J.
Total Number of Pages in this Submission	18	Attorney Docket Number	CS22815RL

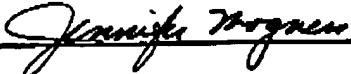
ENCLOSURES		(check all that apply)
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<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Communication to Group
<input type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Licensing-Related papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition	<input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> Affidavits/Declaration(s)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input checked="" type="checkbox"/> Extension of time Request	<input type="checkbox"/> Power of Attorney, Revocation, Change of Correspondence Address	<input type="checkbox"/> Status Letter with appropriate copies
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	<input type="checkbox"/> Other Enclosure(s) (please identify below)
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<input type="checkbox"/> Certified Copy of Priority Documents	<input type="checkbox"/> CD, Number of CDs	<input type="checkbox"/> Associate Power of Attorney
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application	<input type="checkbox"/> Remarks _____	<input type="checkbox"/> RCE
<input type="checkbox"/> Response to Missing Parts Under 37 CFR 1.52 or 1.53		<input type="checkbox"/> Transmittal Form

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual	Matthew C. Loppnow	Registration No.	45,314
Signature			
Date	07/25/2006		

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Signature	
	Date
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Fee Transmittal Patent fees are subject to annual revision					Complete if Known <table border="1"> <tr> <td colspan="2">Application Number</td> <td colspan="3">10/693,248</td> </tr> <tr> <td colspan="2">Filing Date</td> <td colspan="3">10/24/2003</td> </tr> <tr> <td colspan="2">First Named Inventor</td> <td colspan="3">GORDECKI, RYSZARD J.</td> </tr> <tr> <td colspan="2">Examiner Name</td> <td colspan="3">GELIN, JEAN ALLAND</td> </tr> <tr> <td colspan="2">Group Art Unit</td> <td colspan="3">2617</td> </tr> <tr> <td colspan="2">Attorney Docket No.</td> <td colspan="3">CS22815RL</td> </tr> </table>					Application Number		10/693,248			Filing Date		10/24/2003			First Named Inventor		GORDECKI, RYSZARD J.			Examiner Name		GELIN, JEAN ALLAND			Group Art Unit		2617			Attorney Docket No.		CS22815RL																																																																																																																																																																																																															
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

5 APPLICANT: GORDECKI EXAMINER: Gelin, J.
SERIAL NO.: 10/693,248 GROUP: 2617
FILED: October 24, 2003 CASE NO.: CS22815RL
10 ENTITLED: CELLULAR TELEPHONE WITH IMPROVED MECHANICAL DESIGN

15 Motorola, Inc.
Intellectual Property Department
600 North U.S. Highway 45
Libertyville, IL 60048

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

20
25 MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

30 In response to the Office Action dated January 30, 2006, Applicant submits the present
Appeal Brief.

07/27/2006 HARDELR1 00000010 502117 10693248
02 FC:1402 500.00 DA

Appl. No. 10/693,248
Atty. Docket No. CS22815RL

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Appl. No. 10/693,248
Atty. Docket No. CS22815RL

I. REAL PARTY IN INTEREST

The real party in interest is, Motorola, Inc.

5

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

10

III. STATUS OF CLAIMS

Claims 1, 3-10, and 14-22 are pending. Claims 1, 3-10, and 14-22 are rejected and are the subject of the present appeal.

15

IV. STATUS OF AMENDMENTS

No amendments were filed subsequent to final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

20

The inventions are drawn generally to a cellular telephone (100, 700). The cellular telephone can include a lower half (102, 704) that includes a keypad (105) and an upper half (106, 704) coupled to the lower half by a hinge (108, 706). The upper half can have a lower part (110, 708) coupled to the hinge, the lower part including a display (116), and a pivoting head (112, 710) coupled to the lower part, the pivoting head including a camera (122, 716) (Fig. 1, 2 and 7, page 3, line 17 - page 4, line 6, and page 11, line 21 - page 12, line 5).

25

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

30

1. Whether claims 17-19 are patentable under 35 U.S.C. § 112, second paragraph.
2. Whether claims 1-9, 16, 17, 20, and 22 are patentable under 35 U.S.C. § 102 over Matsumoto (U.S. Patent Pub. No. 2003/0228847).

Appl. No. 10/693,248
Atty. Docket No. CS22815RL

VII. ARGUMENT

Claim Limitations At Issue

5

In Claim 1, the limitations at issue are italicized below:

1. A cellular telephone comprising:

a first part having a longitudinal axis substantially in the center of the first part,

10 *the first part including a display;*

a second part coupled to the first part by a pivot mechanism that includes a pivot axis that makes an angle of less than ninety degrees with the longitudinal axis of the first part, whereby the second part can be oriented to face different azimuthal angles about the longitudinal axis of the first part, the second part including a camera; and

15 *a third part connected to the first part by a hinge that includes a hinge axis, the third part including a keypad.*

In Claim 17, the limitations at issue are italicized below:

20 17. A flip type portable telephone comprising:

a first section including a keypad; and

a flip second section connected to the first section by a hinge, wherein the flip section comprises:

a first part that is coupled to the hinge, the first part comprising a first

25 *display; and*

a pivoting head coupled to the first part by a pivot, wherein the pivot allows the pivoting head to be oriented to face different directions, and wherein the pivoting head includes a camera.

30 In Claim 20, the limitations at issue are italicized below:

20. A cellular telephone comprising:

a first part having a longitudinal axis, the first part including a display; and

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a second part coupled to the first part by a pivot mechanism that includes a pivot axis that makes an angle of less than ninety degrees with the longitudinal axis of the first part, whereby the second part can be oriented to face different azimuthal angles about the longitudinal axis of the first part,

Applicants' Argument

The rejection under 35 U.S.C. § 112, second paragraph is improper because the Office Action has not provided a proper basis for the rejection.

15 **Action has not provided a proper basis for the rejection.**

The Office Action rejected claims 17-19 under 35 U.S.C. § 112, second paragraph. The Office Action alleged "the phrases 'a first section', 'a flip second section', and so on are not consistent with at least claim 1. For instant in claim 1, the Applicant refers to the first section as 'the third section'. It appears that the Applicant gives more than one name to a single feature." This rejection is respectfully traversed.

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25 Applicants assert the rejection under 35 U.S.C. § 112, second paragraph is improper because the Office Action has not provided a proper basis for the rejection. In particular, the Office Action alleges claim terms must be consistent between two independent claims, such as claim 17 and claim 1. However, there is no basis in the MPEP, the statutes, or case law for such an allegation. Furthermore, one of ordinary skill in the art would clearly understand what is being claimed in claims 17-19. Additionally, Applicant asserts two different independent claims must include at least one different claim term under the doctrine of claim differentiation. Thus, the Office Action has not provided a proper foundation for the rejection under 35 U.S.C. § 112, second paragraph. Accordingly, Applicants request withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

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The Rejection under 35 U.S.C. § 102

5 The Office Action rejects, under 35 U.S.C. § 102, claims 1-9, 16, 17, 20, and 22 over Matsumoto (U.S. Patent Pub. No. 2003/0228847). The Office Action also rejects, under 35 U.S.C. § 103, claims 10, 15, 18, 19, and 21 over Wilk (U.S. Patent No. 6,643,124) and Matsumoto. These rejections are respectfully traversed.

10 The Rejection under 35 U.S.C. § 102 is improper because Matsumoto does not disclose all of the claimed elements in the claimed combination

15 "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" (MPEP §2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Claim 1

20 Applicant asserts Matsumoto does not disclose or suggest a first part, a second part coupled to the first part by a pivot mechanism, the second part including a camera, and a third part connected to the first part by a hinge that includes a hinge axis, the third part including a keypad, as recited in independent claim 1.

25 In particular, Matsumoto does not disclose the claimed first part including a display and the third part including a keypad, the third part connected to the claimed first part by a hinge. The Office Action alleges Matsumoto discloses element 11 as a first part, element 10 as a second part, and element 3 as a third part. However, element 3 is not connected to element 11 by a hinge. In particular, element 3 is clearly connected to element 10 by the hinge 9. Thus, Matsumoto does not disclose the claimed third part connected to the first part by a hinge.

30 In the Response to Arguments section, the Advisory Action alleges the first part [of Matsumoto] is connected to the third part at least indirectly. However, Applicant is not claiming an indirect connection of elements. In particular, the claims clearly recite the explicit connection of elements. The Advisory Action appears to believe all the elements were found

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in a different combination and then ignores the connection of elements explicitly recited in the claims. Thus, the Advisory Action is attempting to improperly ignore the clear claim language and the connection of elements in the claims. The Advisory Action then goes on to allege Matsumoto teaches all of the features of the claimed invention such as the hinge and the pivot mechanism to connect the keypad, the display, and the camera. However, once again, the Advisory Action ignores the claimed interrelation and connection of elements. Therefore, the Office Action and the Advisory action have not provided the claimed combination of elements in a single reference.

The Advisory Action then alleges, "Anyone of ordinary skill in the art can rearrange the parts disclosed by Matsumoto to arrive at the claimed invention." Applicants disagree with the premise of such an allegation. In particular, the allegation admits Matsumoto does not disclose the claimed invention. In particular, the allegation admits the elements of Matsumoto must be rearranged to obtain the claimed invention. Therefore, the Matsumoto does not disclose the express combination of each and every element of the invention as claimed.

In fact, despite the fact that the premise of the allegation does not support a rejection under 35 U.S.C. § 102, the allegation is not even proper to support a rejection under 35 U.S.C. § 103. In particular, MPEP § 2143.01(III) expressly states, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)." Furthermore, MPEP § 2143.01(IV) expressly states, "A statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Leengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)."

Thus, the Advisory Action makes allegations that not only do not support a rejection under 35 U.S.C. § 102, they also do not support a rejection under 35 U.S.C. § 103.

Therefore, Matsumoto does not disclose or suggest a first part, a second part coupled to the first part by a pivot mechanism, the second part including a camera, and a third part connected to the first part by a hinge that includes a hinge axis, the third part including a keypad, as recited in independent claim 1.

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Claim 17

5 Applicant also asserts Matsumoto does not disclose first section including a keypad and a flip second section connected to the first section by a hinge, wherein the flip section comprises a first part that is coupled to the hinge, the first part comprising a first display and a pivoting head coupled to the first part by a pivot, wherein the pivot allows the pivoting head to be oriented to face different directions, and wherein the pivoting head includes a camera, as recited in independent claim 17.

10 In particular, Matsumoto does not disclose the claimed first part comprising a first display and a first section including a keypad, the first section coupled to a hinge. The Office Action alleges Matsumoto discloses element 11 as a first part, element 10 as a second part, and element 3 as a third part. However, element 11 is not coupled to the hinge 9. In particular, element 1 is clearly connected to element 10 and not connected to the hinge 9. 15 Thus, Matsumoto does not disclose the claimed first part comprising a first display and a first section including a keypad, the first section coupled to a hinge. Furthermore, Matsumoto does not disclose a pivoting head including a camera. In particular, as illustrated in Fig. 4, only the display section 11 pivots and the display section 11 does not include the camera 21.

20 The Advisory Action alleges, "Claims 17 and 20 include nothing more than what has been disclosed in claim 1. Therefore the rejections are maintained for the same reason." Applicant disagrees. In particular, the Advisory Action completely ignores the features of "a flip second section" that includes a "first part that is coupled to [a] hinge, the first part comprising a first display" and "a pivoting head coupled to the first part by a pivot..., wherein the pivoting head includes a camera." These features include express labels and structural 25 interconnections that are not disclosed in Matsumoto, as discussed above. Accordingly, the Advisory Action does not make up for the deficiencies of the final Office Action.

30 Thus, Matsumoto does not disclose first section including a keypad and a flip second section connected to the first section by a hinge, wherein the flip section comprises a first part that is coupled to the hinge, the first part comprising a first display and a pivoting head coupled to the first part by a pivot, wherein the pivot allows the pivoting head to be oriented to face different directions, and wherein the pivoting head includes a camera, as recited in independent claim 17.

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Claim 20

5 Applicant further asserts Matsumoto does not disclose a second part including a first surface and a second surface, a pivot axis tilted with respect to the longitudinal axis by an angle of alpha, and the first surface and the second surface tilted in opposite directions with respect to the pivot axis by the angle alpha, as recited in independent claim 20.

10 Matsumoto does not disclose all of the features recited in independent claim 20 and such is not asserted by the Office Action. The Office Action only alleges Matsumoto discloses, at paragraphs 30-32, a second part can be oriented to face different azimuthal angles about the longitudinal axis of the first part. However, the Office Action does not even address the claimed features of a first surface and a second surface, a pivot axis tilted with respect to the longitudinal axis by an angle of alpha, and the first surface and the second surface tilted in opposite directions with respect to the pivot axis by the angle alpha. Furthermore, Applicant cannot locate the claimed features in the Matsumoto.

15 The Advisory Action alleges, "Claims 17 and 20 include nothing more than what has been disclosed in claim 1. Therefore the rejections are maintained for the same reason." Applicant disagrees. In particular, the Advisory Action completely ignores the features of a second part comprising a first surface and a second surface, a pivot axis tilted with respect to the longitudinal axis by an angle of alpha, and a first surface and a second surface tilted in opposite directions with respect to the pivot axis by the angle alpha. Accordingly, the 20 Advisory Action does not make up for the deficiencies of the final Office Action.

Thus, Matsumoto does not disclose all of the features recited in independent claim 20 and such is not even asserted by the Office Action.

25 Therefore, Applicant respectfully submits that independent claims 1, 17, and 20 define patentable subject matter. The remaining claims depend from the independent claims and therefore also define patentable subject matter. Accordingly, Applicant respectfully requests the withdrawal of the rejection under 35 U.S.C. § 102 and 35 U.S.C. § 103, with instructions for the Examiner to allow the pending claims.

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CONCLUSION

5 In view of the discussion above, the claims of the present application are in condition for allowance. Kindly withdraw any rejections and objections and allow this application to issue as a United States Patent without further delay.

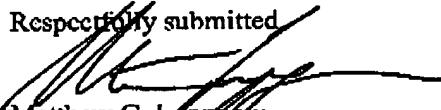
The Commissioner is hereby authorized to deduct the fees for filing a brief in support of an appeal and any fees arising as a result of this Appeal Brief or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

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VIII. CLAIMS APPENDIX

1. A cellular telephone comprising:

a first part having a longitudinal axis substantially in the center of the first part,

5 the first part including a display;

a second part coupled to the first part by a pivot mechanism that includes a pivot axis that makes an angle of less than ninety degrees with the longitudinal axis of the first part, whereby the second part can be oriented to face different azimuthal angles about the longitudinal axis of the first part, the second part including a camera; and

10 a third part connected to the first part by a hinge that includes a hinge axis, the third part including a keypad.

2. (canceled)

15 3. The cellular telephone according to claim 2 wherein:

the hinge axis is normal to the pivot axis.

4. The cellular telephone according to claim 1 wherein:

the pivot axis makes an angle of less than 20 degrees with the longitudinal axis.

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5. The cellular telephone according to claim 4 wherein:

the pivot axis makes an angle of less than 15 degrees with the longitudinal axis.

25 6. The cellular telephone according to claim 1 wherein:

the first part comprises a first surface;

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the second part comprises a second surface located adjacent the first surface of
the first part; and

the pivot mechanism comprises:

a pinion extending from one of the first and second surfaces; and

5 a hole formed in another of the first and second surfaces, wherein the pinion
extends into the hole.

7. The cellular telephone according to claim 6 further comprising:

a spring seat located in one of the first and second parts, around the hole;

10 a spring retainer attached to the pinion; and

a coil spring located around the pinion between the spring seat and the spring
retainer.

8. The cellular telephone according to claim 6 further comprising:

15 an annular, axially acting cam disposed on one of the first and second surfaces;

and

an annular, axially engaging follower disposed on another of the first and
second surfaces, and positioned to engage the axially acting cam.

20 9. The cellular telephone according to claim 8 wherein:

the annular axially acting cam is concentric to the pinion; and

the annular axially engaging follower is concentric to the hole.

10. The cellular telephone according to claim 1 wherein:

25 the second part comprises an second display.

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11-13. (canceled)

14. The cellular telephone according to claim 1 wherein:

5 the second part comprises a camera.

15. The cellular telephone according to claim 14 wherein:

the second part comprises a display, wherein the display and the camera face in
opposite directions.

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16. The cellular telephone according to claim 1 further comprising:

a stop mechanism for limiting rotation of the first part relative to the second
part.

15

17. A flip type portable telephone comprising:

a first section including a keypad; and

a flip second section connected to the first section by a hinge, wherein the flip
section comprises:

a first part that is coupled to the hinge, the first part comprising a first

20 display; and

a pivoting head coupled to the first part by a pivot, wherein the pivot
allows the pivoting head to be oriented to face different directions, and wherein the pivoting
head includes a camera.

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18. The flip type portable telephone according to claim 17 wherein:

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the pivoting head comprises a camera and a display that face in opposite directions.

19. The flip type portable telephone according to claim 18 wherein:

5 the pivoting head further comprises an earpiece speaker.

20. A cellular telephone comprising:

a first part having a longitudinal axis, the first part including a display; and
a second part coupled to the first part by a pivot mechanism that includes a

10 pivot axis that makes an angle of less than ninety degrees with the longitudinal axis of the first part, whereby the second part can be oriented to face different azimuthal angles about the longitudinal axis of the first part,

wherein

the second part comprises a first surface and a second surface;

15 the pivot axis is tilted with respect to the longitudinal axis by an angle of alpha;

and

the first surface and the second surface are tilted in opposite directions with respect to the pivot axis by the angle alpha.

20 21. The cellular telephone according to claim 20 wherein:

the first part comprises a third surface and a first display located at the third surface; and

the second part comprises a second display that is disposed at the first surface of the second part.

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22. The cellular telephone according to claim 20 further comprising:
a third part coupled to the first part by a hinge, that includes a hinge axis,
wherein the hinge axis is perpendicular to the longitudinal axis.